

REMARKS

Claims 17-46 and 72-73 were pending.

Claims 47-71 are withdrawn.

Claims 17-19, 21-46 and 72-73 are rejected.

Claim 34 is cancelled.

Claim 74 is new.

Claims 17, 25, 35, 36, 40 and 73 are amended.

Claims 17-19, 21- 33, 35-46 and 72-74 are pending.

Continuity Information

The Applicants have included continuity information directly after the title on the first page of the specification.

Applicants thank the examiner for acknowledgement of the claim for foreign priority and receipt of the certified copies of the priority documents.

Amended Claim 17

Applicants have amended claim 17 by incorporating the limitation of claim 34. Claim 34 has been cancelled as it no longer limits claim 17.

New claim 74 is supported by the disclosure on page 7, last paragraph and examples on page 8, Table 1.

Amended claims 25, 35, 36, 40 and 73 are amended to correct minor errors.

No new matter has been added.

35 USC 103(a)

Claims 17-19, 21-44, 46, 72 and 73 are rejected under 35 USC 103(a) as being unpatentable over Aho et al, WO 98/54410.

Examiner refers specifically to example 1 in Aho.

Example 1 of Aho shows a water soluble component (sodium carboxymethylcellulose) which makes up only about 0.38 wt. % of the total talc dispersion. The amount of the sodium polyacrylate (latex) makes up less than half the water soluble component. The latex and talc weight together about 63 wt. % of the total pigment fraction ($2700\text{g} + 8.2\text{g}/4312.4\text{g} = 62.8\text{ wt \%}$). The sizing fraction makes up about 0.38 wt. % water soluble polymer. Thus the wt. ratios of pigment fraction to sizing fraction in example 1 of Aho is 62.8 to 0.38 or 165:1. This ratio of pigment fraction to sizing fraction is not encompassed by present claim 17 (10/90 to 90/10).

Furthermore although Aho teaches the employment of various latexes and the employment of modified starches, Aho does not teach or suggest the combination of a synthetic binder or latex in a pigment fraction with a sizing fraction comprising a water-soluble component in the ratio of 10/90 to 90/10 of claim 17. Thus Aho cannot make the present claims obvious and the 103(a) rejection is overcome.

Claim 45 is rejected under 35 USC 103(a) as being unpatentable over Aho et al, WO 98/54,410, as applied to claim 17 above and further in view of Niinikoski et al US 6,753,377.

The examiner alleges that the combination of Niinikoski with Aho arrives at all the elements of claim 45.

Applicants point out that Niinikoski does not correct the deficiencies of Aho. That is, Aho as explained above does not suggest or teach the combination of a synthetic binder or latex in a pigment fraction with a sizing fraction comprising a water-soluble component in the ratio of 10/90 to 90/10 as read in claim 17. Thus the combination of Niinikoski and Aho does not arrive at the present invention and therefore cannot be obvious.

Reconsideration and withdrawal of the rejection of claims 17-19, 21-46 and 72-74 is respectfully solicited in light of the remarks and amendments *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 17-19, 21-46 and 72-74 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Shiela A. Loggins". The signature is fluid and cursive, with the first name "Shiela" being more prominent.

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-7127
SAL\23134.doc

Shiela A. Loggins
Agent for Applicants
Reg. No. 56,221